

particular attention to the points raised in the Office Action. By the present Amendment, independent claims 1, 4, 7, 9, and 11 have been amended to simply clarify the claim language. It is submitted that no new matter has been added and no new issues have been raised by the present Amendment.

The objections to the drawings have been addressed hereby in a Letter With Proposed Drawing Changes, as required by the Office Action in paragraph 3.

The title of the invention has been amended to read -- NETWORK SYSTEM, NETWORK SERVER AND TERMINAL DEVICE FOR RECORDING, CONVERTING, AND TRANSMITTING INFORMATION CONFORMED TO A TERMINAL DEVICE--, as required by the Office Action in paragraph 4.

The typographical error as noted in the specification has been corrected hereby.

Reconsideration is respectfully requested of the objection to claims 2, 3, 5, 6, 8, and 10-12 for mentioning the network server forms "a group of users." The Office Action maintains that the network server actually forms "a group of terminal devices used by users." Some non-limiting examples to support the claims as written may be found in the specification on page 2, lines 18-24; page 8, line 23 to page 9, line 6; and page 28, lines 17-20.

Reconsideration is respectfully requested of the rejection of claims 1-3, 7, and 8 under 35 U.S.C. § 103(a), as being unpatentable over US Patent No. 6,230,002 to Flodén et al. in view of U.S. Patent No. 5,557,659 to Hyde-Thomson.

Applicants have carefully considered the Examiner's comments

and the cited references, and respectfully submit that amended independent claims 1 and 7 are patentable over the cited references for at least the following reasons.

This invention is intended to improve a network system comprising a terminal device, and a network server connected to the terminal device via prescribed communication means, wherein a user of the network system and the terminal device to be used by the user are recorded in the network server, and the network server converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user, and transmits the conformed information to the terminal device.

Claims 1 and 7 have been amended hereby to emphasize the features of the claimed invention described above.

Flodén et al., as understood by Applicants, relates to an improvement of an assembly for selectively permitting access by a mobile terminal to a packet data network, thereby to permit communications between the mobile terminal and the host site, the assembly comprising a processing device releasably coupled to, and carried by, the mobile terminal. The processing device has a password-generation algorithm executable thereon, for generating a password when the password-generation algorithm is executed. An authentication server is coupled to the packet data network and forms a portion thereof, for receiving the password generated responsive to execution of the password-generation algorithm, and for authenticating the mobile terminal responsive to values of the password generated by the processing device and received at

the authentication server. The mobile terminal is permitted to communicate with the host site when the password is authenticated by the authentication server.

The Office Action notes that Flodén et al. does not disclose that the network server converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user, and, for that reason, Hyde-Thomson is cited to show a network server that converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user.

Hyde-Thomson, as understood by Applicants, relates to a method of integrating voice messages with text messages in an electronic mailing system comprising the steps of generating a single directory with contains a plurality of e-mail addresses, and extension numbers, receiving a forwarded incoming telephone call, determining a called party's extension number, recording a voice message from the incoming telephone call as a digital voice file, attaching the voice file to an e-mail message as part of an e-mail system according to an application program of an e-mail system, determining an e-mail mailbox address from the directory based on the extension number, sending the e-mail message with its voice file in association with its mailbox address, and playing back the voice messages over a telephone.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art itself suggested the desirability of

the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The motivation to modify cannot come from the present invention. See Heidelberger Drucksmaschinen AG v. Hantscho Commercial Products, 21 F.3d 1068, 1072, 30 U.S.P.Q.2d 1377, 1380 (Fed. Cir. 1994).

It has been held that "[a] rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art . . . The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." In re Warner and Warner, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (CCPA 1967).

The Office Action maintains Flodén et al. teaches a network system, a terminal device, and a network server connected to the terminal device via prescribed communication means, wherein the terminal device to be used by a user of the system is recorded in the network server, and the network transmits information to the terminal device used by the user. The Office Action further maintains Hyde-Thomson teaches that it is necessary to convert information (data) format when transferring information from one end to the other end that requires different information format.

Applicants do not maintain they have merely invented a network system, a terminal device, and a network server connected to the terminal device via prescribed communication means. It is that a user of the network system and the terminal device to be

used by the user are recorded in the network server, and the network server converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user, and transmits the conformed information to the terminal device that forms some of the important features of this invention, as set forth in the amended claims.

Applicants respectfully submit that, even combining Flodén et al. with Hyde-Thomson, the subject matter of amended independent claims 1 and 7 are not disclosed.

Flodén et al. provides no suggestion of any benefits to be had by incorporating a network server connected to the terminal device via prescribed communication means. The Office Action maintains that there are various ways of communication means to connect different types of terminal devices to a network server in order to form the network system. On the contrary, Flodén et al. appears to specifically apply only to a wireless host using a mobile terminal (Fig. 1, col. 1, lines 6-13). This is the typical design this invention seeks to improve. See specification, page 5, line 20 to page 6, line 12. Equipping the uplink signals 32 generated by the wireless communication station of Flodén et al. with prescribed communication means therefore directly contradicts the teachings of Flodén et al.

Flodén et al. also provides no suggestion of any benefits to be had by recording a user of the network system and the terminal device to be used by the user in the network server. On the contrary, Flodén et al. appears to show a Subscriber Identity

Module (SIM) including subscriber information, which is releasably coupled to the mobile terminal, presumably for improved authentication security results (col. 1, lines 13-17, and col. 2, lines 20-26. Flodén et al. makes no mention whatsoever of recording a user of the network system and the terminal device to be used by the user in the network server. This is the typical design this invention seeks to improve. See specification, page 15, lines 1-6. Equipping the SIM of Flodén et al. with recording a user of the network system and the terminal device to be used by the user in the network server therefore directly contradicts the teachings of Flodén et al.

Furthermore, Flodén et al. provides no suggestion of any benefits to be had by incorporating a network server for transmitting conformed information conformed to the terminal device used by the user to the terminal device. On the contrary, the cited portions of Flodén et al. merely reference an authentication server generating a request for a password to be provided by the wireless host (col. 3, lines 41-44).

Hyde-Thomson is likewise completely silent regarding the benefits of a network server that converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user as in this invention. Incorporating a network server that converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user in Hyde-Thomson is useless because Hyde-Thomson utilizes a board in a voice gateway PC that

connects to a phone system to accept incoming calls and convert the analog voice signal into a digital format that is stored on a file server. The digital voice file is attached to an e-mail and retrieved and transferred by the gateway PC, and the board which is connected to the phone system converts the voice file from a digital format back to an analog voice signal for playback over the phone line (col. 3, lines 38-53).

Providing Flodén et al. and Hyde-Thomson with a network server connected to the terminal device via prescribed communication means, wherein a user of the network system and the terminal device to be used by the user are recorded in the network server, and the network server converts information to be transmitted to the terminal device used by the user into conformed information conformed to the terminal device used by the user, and transmits the conformed information to the terminal device as the Office Action suggests would therefore contradict the teachings of both Flodén et al. and Hyde-Thomson.

Accordingly, for the above-stated reasons, it is respectfully submitted that amended independent claims 1 and 7 are patentable over the cited references.

Accordingly, for the above-stated reasons, it is respectfully submitted that claims 1-3, 7 and 8 are patentable over the cited reference.

Claims 2, 3, and 8 also depend from claims 1 and 7 which for the reasons set forth hereinabove are thought to be patentably distinct over the cited references and, for at least those very same reasons, claims 2, 3, and 8 are also submitted to be

patentably distinct thereover.

Reconsideration is respectfully requested of the rejection of claims 4-6, 9, and 10 under 35 U.S.C. § 103(a), as being unpatentable over Flodén et al. in view of U.S. Patent No. 6,138,158 to Boyle et al.

Applicants have carefully considered the Examiner's comments and the cited references, and respectfully submit that amended independent claims 4 and 9 are patentable over the cited references for at least the following reasons.

This invention is intended to improve a network system comprising a terminal device, and a network server connected to the terminal device via prescribed communication means, wherein a user of the network system and the terminal device used by the user are recorded in the network server, and when there is information to be transmitted to the terminal device used by the user, the network server notifies the terminal device used by the user of the presence of the information to be transmitted.

Claims 4 and 9 have been amended hereby to emphasize the features of the claimed invention described above.

The Office Action notes that Flodén et al. does not disclose when there is information to be transmitted to the terminal device used by the user, the network server notifies the terminal device used by the user of the presence of the information to be transmitted and, for that reason, Boyle et al. is cited to show such a notification.

Boyle et al., as understood by Applicants, relates to a method of integrating a narrowband channel and a wideband channel

used to communicate between a plurality of client device and a link infrastructure, comprising receiving a notification in the link infrastructure from a web server when specific information is updated at the web server, the specific information subscribed by the client device and identified by the notification, wherein the notification comprises a subscriber identifier identifying a user account.

The Office Action maintains Flodén et al. teaches a network system, a terminal device, and a network server connected to the terminal device via prescribed communication means, wherein the terminal device to be used by a user of the system is recorded in the network server, and the network transmits information to the terminal device used by the user. The Office Action further maintains Boyle et al. teaches that when there is an update of a server content, the mobile (sic) would be notified with a message to make users aware that there is information for a user to receive so the user can make a decision if they want to receive this information or not.

Claims 4 and 9 are thought to be patentably distinct over Flodén et al. for at least the very same reasons as claims 1 and 7.

Accordingly, for the above-stated reasons, it is respectfully submitted that amended independent claims 4 and 9 are patentable over the cited references.

Claims 5, 6, and 10 depend from claims 4 and 9 which for the reasons set forth hereinabove are thought to be patentably distinct over the cited references and, for at least those very

same reasons, claims 5, 6, and 10 are also submitted to be patentably distinct thereover.

Reconsideration is respectfully requested of the rejection of claims 11 and 12 under 35 U.S.C. § 103(a), as being unpatentable over Flodén et al.

Applicants have carefully considered the Examiner's comments and the cited reference, and respectfully submit that amended independent claim 11 is patentable over the cited reference for at least the following reasons.

Claim 11 is thought to be patentably distinct over Flodén et al. for at least the very same reasons as claims 1-3.

Accordingly, for the above-stated reasons, it is respectfully submitted that amended independent claim 11 is patentable over the cited reference.

Claim 12 depends from claim 11 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited reference and, for at least those very same reasons, claim 12 is also submitted to be patentably distinct thereover.

Attached hereto is a version with markings to show changes made to the specification and claims by the current amendment.

The references cited as of interest have been reviewed, but are not seen to show or suggest the present invention as recited in the amended claims.

The Office is hereby authorized to charge any additional fees which may be required in connection with this Amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of

7217/61041

this application, the Examiner is respectfully requested to call
the undersigned attorney.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP



Jay H. Maioli
Reg. No. 27,213

JHM:SL

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

The title has been amended as follows:

NETWORK SYSTEM, NETWORK SERVER AND TERMINAL DEVICE FOR RECORDING, CONVERTING, AND TRANSMITTING INFORMATION CONFORMED TO A TERMINAL DEVICE.

The paragraph beginning on page 6, line 13 has been amended as follows:

Here, each terminal device (television set 13, cellular phone 31 and personal computer 47) has a slot to insert a memory card 11_x (11₁, 11₂, 11₃, . . .) being storage means. When operating these terminal devices, the user inserts the memory card 11_x (11₁, 11₂, 11₃, . . .) that is individually owned by [him] the user in the above operating terminal. As shown in Fig. 2, the memory card 11_x (11₁, 11₂, 11₃, . . .) is composed of a connector 11B to connect to the slot of each terminal device and a memory 11A that is connected to the above connector 11B via a bus BUS.

IN THE CLAIMS

Claims 1-4 and 6-11 have been amended hereby to correct formal matters only.

1. (Twice Amended) A network system comprising:
a terminal device; and
a network server connected to said terminal device via

prescribed communication means, wherein a user of the network system and said terminal device to be used by [a] the user [of the system is] are recorded in said network server, and said network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user, and transmits the conformed information to said terminal device.

2. (Twice Amended) The network system according to claim 1, wherein[;] said network server forms a group of a plurality of users and transmits information sent from a user belonging to said group to a terminal device used by another user belonging to said group.

3. (Twice Amended) The network system according to claim 2, [wherein] further comprising storage means, and wherein said terminal device includes interface means connected to said storage means for storing information peculiar to said user and for storing specific information on said group to which said user belongs in said storage means connected to said interface means.

4. (Twice Amended) A network system comprising:
a terminal device; and
a network server connected to said terminal device via prescribed communication means, wherein a user of the network system and said terminal device used by [a] the user [is] are recorded in said network server, and when there is information to

be transmitted to said terminal device used by the user, said network server notifies said terminal device used by the user of the presence of the information to be transmitted.

6. (Twice Amended) The network system according to claim 5, further comprising storage means, and wherein said terminal device includes interface means connected to said storage means for storing information peculiar to said user and for storing specific information on said group to which said user belongs in said storage means connected to said interface means.

7. (Twice Amended) A network server connected to a terminal device via prescribed communication means, comprising:
recording means for recording a user of said terminal device and said terminal device used by [a] the user; and
transmission means for converting information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user, and transmitting said conformed information to said terminal device.

8. (Twice Amended) The network server according to claim 7, [wherein] further comprising group forming means for forming a group of a plurality of users, wherein said transmission means transmits information sent from a user belonging to said group to a terminal device used by another user belonging to said group.

9. (Twice Amended) A network server connected to a terminal device and via prescribed communication means, comprising:

recording means for recording a user of said terminal device and said terminal device used by the user; and

notice means for notifying, when there is information to be transmitted to said terminal device used by the user, said terminal device used by the user of the presence of the information to be transmitted.

10. (Twice Amended) The network server according to claim 9, further comprising group forming means for forming a group of said a plurality of users[;], and when there is information sent from a user belonging to said group, said notice means notifies a terminal device used by another user belonging to said group of the presence of the information sent from the user.

11. (Twice Amended) A terminal device connected to a network server via prescribed communication means, comprising:

specific information transmission means for transmitting information specific to a user using said terminal device and information specific to said terminal device to said network server as specific information;

group specifying information receiving means for receiving group specifying information to specify a group [to which] of a plurality of users including the user using said terminal device; and

7217/61041

storage means for storing said received group specifying information.